REMARKS

I. Status of the Application

Claims 12-16 are pending in this application. In the October 20, 2005 Office Action, the Examiner:

A. Required affirmation of a provisional election of a single disclosed species from Species A (claims 12-15) and Species B (claim 16) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable; and

B. Rejected claims 12-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4 and 7 of U.S. Patent No. 6,699,766 to Taravarde et al. (hereinafter "the '766 Patent").

In this response, claim 16 has been withdrawn from consideration as being drawn to the non-elected species. Applicants traverse the double patenting rejection and respectfully request reconsideration in light of the amendments and the following remarks.

II. Election

In response to the Restriction Requirement in the October 20, 2005 Office Action, Applicants hereby affirm election of Species A, i.e. claims 12-15, for prosecution on the merits.

III. Double Patenting Rejection of Claims 12-15 Should Be Withdrawn

Claims 12-15 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4 and 7 of U.S. Patent No. 6,699,766. For the reasons discussed below, U.S. Patent No. 6,699,766 cannot be used as a reference against the present application.

The '766 Patent issued from application 10/185,537 filed Jul. 1, 2002. The present application is a divisional application of application no. 10/185,537. In an Office Action mailed January 13, 2003 for application 10/185,537, a restriction under 35 U.S.C. § 121 was required between Species I (claims 1-11) and Species II (claims 12-16). An election was made to prosecute Species I in application 10/185,537, and claims 12-16 were withdrawn from consideration in 10/185,537. Claims 12-16 were included in the present application as originally filed in 10/185,537.

The third sentence of *35 U.S.C. § 121* states the following:

> A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

Thus, *35 U.S.C § 121* shields a divisional application from an obvious-type double patenting rejection based on the parent application when certain circumstances are met. The *35 U.S.C § 121* shield applies only where the Office has made a requirement for restriction, the claims in the divisional application are consonant with the subject matter that was restricted in the parent application, and the divisional application was filed before the issuance of the patent. *MPEP* § 804.1. The shield does not apply where the divisional application was

voluntarily filed by the applicant and not in response to an Office requirement for restriction. *Id.* As mentioned above, there was a requirement for restriction made in application 10/185,537 (the '766 Patent). Claims 12-16 were withdrawn from 10/185,537 as a result of the restriction requirement and were subsequently included unamended in the present application.

35 U.S.C § 121 does not provide immunity against a double patenting rejection unless consonance is maintained between the subject matter required to be separated in a restriction requirement and the subject matter later claimed. *Symbol Technologies Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1579, 19 USPQ2d 1241, 1249 (Fed. Cir. 1991); *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 688, 16 USPQ2d 1436, 1440 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. 916 F.2d at 688, 16 USPQ2d at 1440.

Claims 12-16 were filed in the present application as they appeared in the parent application 10/185,537 before the restriction requirement. Claims 12-16 have not been amended since they were withdrawn from consideration in 10/185,537 and presented in this application. Thus, claims 12-16 are in consonance with subject matter required to be separated in the restriction requirement of application 10/185,537.

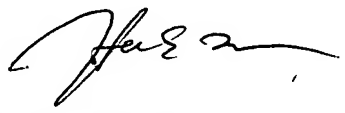
Additionally, in order to qualify for the protection under *35 U.S.C § 121,* the divisional application must have been filed before the issuance of the patent on the parent application. The present application was filed December 11, 2003, and the '766 Patent issued March 2, 2004. Hence, the present application satisfies this requirement as well.

In summary, the present divisional application was filed as a result of a restriction requirement issued by the Office in application 10/185,537; claims 12-15 of the present application are in consonance with the subject matter restricted from 10/185,537; and the present application was filed before the '766 Patent issued on application 10/185,537. Therefore, the present application qualifies for the prohibition of double patenting rejections under *35 U.S.C § 121*. Accordingly, the '766 Patent is prohibited from being used as a reference against the present application. Because it is believed that the double patenting rejections of claims 12-15 have been overcome, and because there were no other grounds for rejection presented in the Office Action, it is submitted that claims 12-15 are allowable as written.

VII. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicants have made a patentable contribution to the art. Favorable reconsideration and allowance of this application is, therefore, respectfully requested.

Respectfully submitted,



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